

S/N: 09/222,554
Response to Office Action dated April 7, 2008
Amendment dated July 7, 2008

REMARKS

Claims 1-9, and 13-25 are pending in the application. Claims 2, 3, and 16 have been amended. Claims 1 and 20 have been canceled without prejudice.

Claim Objections

Claim 16 was objected to for the phrase “one of a component.” Though Applicants contend that the phrase including the rest of the element is proper, the claim has been amended to make the phrase clearer. Reconsideration and withdrawal of the objection to the claim is respectfully requested.

Claim Objection under 37 C.F.R. § 1.75

Claim 2 was objected to as being a substantial duplicate of claim 3. Claims 2 and 3 have been amended, and in view of this amendment, reconsideration and withdrawal of the objection to the claims is respectfully requested.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,101,503 (“Cooper”) in view of U.S. Patent No. 6,182,050 (“Ballard”). Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,256,739 (“Skopp”). To expedite prosecution of this case, claims 1 and 20 have been canceled at this time without prejudice to pursue these claims in one or more continuing applications.

Independent claim 16 recites a method for associating a chosen information unit with a given information unit. First, a user computer system data is automatically determined by

S/N: 09/222,554

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Amendment dated July 7, 2008

running a diagnostic program on the user computer system to determine at least one of a component coupled in the user computer system and a software program loaded on the user computer system. Then, a chosen information unit is selected as a function of the user computer system data. Skopp does not show or suggest these features. The following is a discussion of the sections of Skopp cited by the Office.

Col. 5, lines 26-35 simply refer to the selection of a banner ad on a web-page to obtain limited access to the Internet. There is nothing in this section that refers to running a diagnostic program on the user computer system. Col. 1, lines 32-42 refer to a Copyright Notice for the application and a packet-based communication network. It is unclear how this section relates at all to the present application. Col. 2, line 60 to Col. 3, line 18 refer to identifying a user. This is done through demographic data of the user (e.g., age and income) or through an IP address of the user. The Office Action also cites elements 320-340 of Fig. 3, but those elements do not appear in this figure. The corresponding description in the Action states that it shows “selecting a related advertisement to incorporate into a web page.” In total, the cited sections refer to identifying a user based on IP address or a user’s demographics (age and income) and providing that information to an advertiser. In view of the errors in citation above, Applicants respectfully request clarification of the relevance of the sections of Skopp relied upon in rejecting claim 16.

As admitted in the Office Action, Skopp fails to disclose the running of a diagnostic program on the user computer system. Though it is agreed that such programs were known in the art, the combination presented in the claim is not suggested by the Skopp reference at all. Claim 16 recites selecting a chosen information unit as a function of the user computer system

S/N: 09/222,554

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Amendment dated July 7, 2008

data obtained through the diagnostic program. Since Skopp is concerned with providing identification and demographic information about a user to an advertiser, it is unclear how Skopp would lead one of skill in the art to provide diagnostic information of a user computer system and selecting a chosen information unit as a function of the user computer system data. Since both features of the claim are not taught or suggested by Skopp, the Office is, in essence, rejecting the claim because diagnostic programs are well-known in the art. The claim is not seeking to cover diagnostic programs as such, but the combination of elements presented therein. Applicants respectfully submit that it is improper to reject the claims under 35 U.S.C. § 103(a) based solely on the fact that diagnostic programs are well-known in the art.

Since features of the presently claimed invention are missing from the cited references, reconsideration and withdrawal of the rejection of claim 16 under 35 U.S.C. § 103(a) is respectfully requested.

S/N: 09/222,554
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CONCLUSION

For all the above reasons, the Applicant respectfully submits that this application is in condition for allowance. A Notice of Allowance is earnestly solicited.

The Examiner is invited to contact the undersigned at (408) 975-7500 to discuss any matter concerning this application. The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,
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